



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,239	09/30/2003	Masashi Morioka	243403US8	5391

22850 7590 10/15/2010
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
----------	--------------

3621

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/15/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/673,239	Applicant(s) MORIOKA ET AL.	
	Examiner CHRISTOPHER C. JOHNS	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>EAST Search Notes</u> |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 August 2010 has been entered.

Acknowledgements

2. This Office Action is given Paper No. 20101006 for reference purposes only.
3. This Office Action is in response to the Request for Continued Examination of 30 August 2010 ("August 2010 RCE"). The August 2010 RCE contained, inter alia, Claim Amendments ("August 2010 Amendments") and Remarks/Arguments ("August 2010 Remarks").
4. Claims 15 and 19 are pending.
5. Claims 15 and 19 have been examined.

Claim Objections

6. Claim 19 recites "the authentication and payment server" (page 3, line 15). This is believed to be a typographical error, and is meant to refer to the "authentication and payment device" on line 12.
7. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over IBM NewGenPay (“IBM”) (as disclosed in Electronic Payment Systems for E-Commerce, Second Edition - hereafter “O’Mahony”) in view of U.S. Patent 5,728,999 (“Teicher”).

10. As per claim 19, IBM discloses:

11. terminal (page 293, figure 7.37, **User**) programmed to receive (page 293, figure 7.37, arrow from Payment Provider 1 to User) from the authentication and payment device (page 293, figure 7.37, **Payment Provider 1**) a certificate of service (page 293, figure 7.37, **Daily Spending Certificate**) including a content of a reference amount (page 294, ¶2 - “daily_spend_cert = ...**upper_limit**”);

12. terminal issues a request for use of a service (page 293, figure 7.37, **Signed payment order (PO)**) attached with the certificate of service to the service providing device (page 293, figure 7.37, **Vendor**);

13. service providing device (page 293, figure 7.37, **Vendor**) programmed to receive the request for use of a service from the terminal through the information network (page 293, figure 7.37, ¶5 - “payment = daily_spend_cert...order_desc”);

14. service providing device (page 293, figure 7.37, **Vendor**) compares the reference amount in the certificate of service with an amount of payment of the requested service (page 294, ¶4 -

“the vendor will keep track of how much the user has spent”) to determine whether the amount of payment is less than the reference amount (page 294, ¶4 - “providing the spending limit is not exceeded...”);

15. service providing device transmits a first authentication and payment message (page 295, ¶2 - “vendor forwards the current payment order to the PP) to the A&P device (page 293, figure 7.37, **Payment Provider 1**) prior to providing the requested service (page 295, ¶2 - “vendor forwards the current payment order to the PP, which will respond with a signed authorization to allow further spending”) when the comparing determines that the amount of payment of the service is greater than the reference amount (page 295, ¶2 - “if the spending limit is reached at a particular vendor, and the user attempts a further purchase, an on-line authorization is performed with the user’s PP”);

16. service providing device generates and transmits to the A&P device a second A&P message (page 295, ¶3 - “vendors deposit signed batches of purchase orders to their respective PPs at the end of the day, and these are cleared with the user’s PP...”)) after the requested service has been provided to the terminal (page 293, figure 7.37, **User**) when the amount of payment is less than the reference amount (page 294, ¶4 - “providing the spending limit is not exceeded...”).

17. IBM does not explicitly disclose:

18. transmitting a message immediately after the requested service has been provided.

19. Teicher teaches:

20. transmitting a message (figure 11B, \$SUM Charged to Customer's Remote Credit or Bank Account **1148**) immediately after the requested service has been provided (step **1148** occurs directly after the purchase is concluded in step **1146**).

21. Teicher teaches charging the user's remote account immediately after giving the user his product. This is done in order to more quickly get the money that the user has offered to pay for the product. This, in turn, leads to a more profitable system, because the owner of the machine receives his money more quickly.

22. The sole difference between the reference and the instant application is that the reference does not disclose immediately sending a message in place of sending one at the end of the day. Since each individual timing for sending the message and its function are shown in the prior art (though in different references), the difference between the claimed subject matter and the prior art rests not on an individual element or function, but the combination itself – that is, in the substitution of sending a message immediately after the transaction in IBM. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to send the message immediately after the transaction in place of waiting until the end of the day, because the simple substitution of one known element for another, producing a predictable result, renders the claim obvious. A person having ordinary skill in the art would also find it advantageous because it would create a more profitable system for its owners.

23. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of Teicher, further in view of Admitted Prior Art (under MPEP §2144.03 C).

24. As per claim 15, IBM in view of Teicher discloses as above, but does not explicitly disclose: a wireless terminal apparatus.

25. It is now Admitted Prior Art (under MPEP §2144.03 C) that wireless terminal apparatuses was old and well-known in the art because they allow for a more convenient and robust system of transmitting data. By allowing users to use a mobile device, they are not tied to a specific desk or computer and may roam freely - creating a more convenient system. This also enables different paradigms for accessing services; a user would not be able to bring his desktop computer to a merchant's brick-and-mortar store, so by making the system able to be used on a wireless device, the system becomes more widely-usable. This, in turn, would create a more profitable system for its creators, because a system that is more convenient and more widely-usable is a system that users would be more likely to purchase and use.

26. Therefore, it would have been obvious to a person having ordinary skill in the art to include in IBM and Teicher the concept of a wireless terminal apparatus, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more convenient, widely-usable, and profitable system.

27. Claim 19 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of SET Secure Electronic Transaction Specification ("SET").

28. As per claim 19, IBM discloses as above, but does not explicitly disclose:

29. transmitting a message immediately after the requested service has been provided.

30. SET teaches:

31. transmitting a message immediately after the requested service has been provided (page 69, § 4.6 - “After completing the processing of an order from a cardholder (see Section 4.4), the merchant will request payment”).

32. The method in SET guarantees that the merchant receives his money. It also describes a method to “secure payment card transactions over open networks” (page i, § Secure Electronic Transaction protocol). This creates a more profitable and more secure system.

33. The sole difference between the reference and the instant application is that the reference does not disclose immediately sending a message in place of sending one at the end of the day. Since each individual timing for sending the message and its function are shown in the prior art (though in different references), the difference between the claimed subject matter and the prior art rests not on an individual element or function, but the combination itself – that is, in the substitution of sending a message immediately after the transaction in IBM. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to send the message immediately after the transaction in place of waiting until the end of the day, because the simple substitution of one known element for another, producing a predictable result, renders the claim obvious. A person having ordinary skill in the art would also find it advantageous because it would create a more profitable and secure system.

34. Claim 15 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of SET, further in view of Admitted Prior Art (under MPEP §2144.03 C).

35. As per claim 15, IBM in view of SET discloses as above, but does not explicitly disclose:
a wireless terminal apparatus.

36. It is now Admitted Prior Art (under MPEP §2144.03 C) that wireless terminal apparatuses was old and well-known in the art because they allow for a more convenient and robust system of transmitting data. By allowing users to use a mobile device, they are not tied to a specific desk or computer and may roam freely - creating a more convenient system. This also enables different paradigms for accessing services; a user would not be able to bring his desktop computer to a merchant's brick-and-mortar store, so by making the system able to be used on a wireless device, the system becomes more widely-usable. This, in turn, would create a more profitable system for its creators, because a system that is more convenient and more widely-usable is a system that users would be more likely to purchase and use.

37. Therefore, it would have been obvious to a person having ordinary skill in the art to include in IBM and SET the concept of a wireless terminal apparatus, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more convenient, widely-usable, and profitable system.

Response to Arguments

38. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

Conclusion

39. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to CHRISTOPHER C. JOHNS whose telephone number is (571)270-3462. The Examiner can normally be reached from Monday through Friday from 9am to 5pm. The Examiner's direct fax line is (571) 270-4462.

40. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Christopher C Johns/
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621